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EXAMINER	
MATHEWS, A	
ART UNIT	PAPER NUMBER
2851	

DATE MAILED:

04/11/00

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

1. ☒ The communication filed 12-07-99 is ~~incomplete~~/non-responsive for the reason(s) checked below and should be corrected. APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION (WHICHEVER IS LONGER) WITHIN WHICH TO CORRECT THE INFORMALITY.
- a. ☐ The amendment to claim(s) _____, filed _____, fails to comply with the provisions of 37 C.F.R. 1.121 and is accordingly held to be non-responsive. A supplemental paper correcting the informal portions and complying with the rule is required.
- b. ☐ The paper is unsigned. A duplicate paper or ratification, properly signed, is required.
- c. ☐ The paper is signed by _____, who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record, is required.
- d. ☐ The communication is presented on paper which will not provide a permanent copy. A permanent copy, or a request that a permanent copy be made by the Office at applicant's expense, is required, see M.P.E.P. 714.07.
- e. ☒ Other Applicant failed to comply with part C in the previous office action. See attachment.
2. ☐ In accordance with applicant's request, THE PERIOD FOR RESPONSE FROM THE OFFICE ACTION DATED _____ IS EXTENDED TO RUN _____ MONTH(S).
No further extension will be granted unless approved by the Commissioner. 37 C.F.R. 1.136 (b)
3. ☐ Receipt is acknowledged of papers submitted under 35 U.S.C. 119 which papers have been made of record in the file.
4. ☐ Other

See attachment

DETAILED ACTION

1. The reply filed on December 7, 1999 is not fully responsive to the prior Office action because of the following omission(s) or matter(s):

Applicant failed to fully comply with part C in the previous office action, which states:

- C. Applicant has failed to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application pursuant to 37 CFR 1.607(a)(5).

While Applicant has specifically applied each limitation of copied claim 143 to the disclosure of the application, Applicant has not specifically applied each limitation of copied claims 144-168 to the disclosure of the application.

Applicant argues that Applicant has not had the benefit of the prosecution history of patent 5,796,469, because the file was declared "lost" by the United States Patent and Trademark Office. But the Examiner fails to see why not having the benefit of the prosecution history of patent 5,796,469 would prevent Applicant from specifically applying each limitation of copied claims 144-168 to the disclosure of Applicant's own application.

Applicant further argues that 37 CFR 1.607(a)(5) only requires that Applicant apply the terms of any application claim

- (i) Identified as corresponding to the count and
- (ii) Not previously in the application to the disclosure of the application

But MPEP 2307 states how we are to interpret 37 CFR 1.607(a)(5), by stating:

If Applicant does not apply the terms of the claims presented to the disclosure of the application, i.e., **does not state how each term of the copied claim is supported by the specification, as required by 37 CFR 1.607(a)(5)**, a one month time period should be set to correction of this deficiency.

Absent this explanation applying each limitation of copied claims to the disclosure of the present application, it may be presumed that the copied claims 144-168 do not correspond to the count and may be excluded from the interference.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Alan Mathews at telephone number (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM Eastern Time.

Any inquiry of a general nature or related to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956. The fax phone number for this Group is (703) 305-34[31,32].

Alan A. Mathews

Alan A. Mathews
Primary Examiner

AAM

April 10, 2000